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EXAMINER	
SHELEHEDA, JAMES R	

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/752,632	ZUSTAK ET AL.	
	Examiner	Art Unit	
	James Sheleheda	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-93 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-93 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 06/16/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 1, 11, 12, 13, 18, 27, 28, 29, 30, 50, 52, 66, 87 and 88 are objected to because of the following informalities:

In claim 1, line 5, "the stored entertainment content" should be changed to --stored entertainment content--.

In claim 11, line 1, it is unclear which menu the claim is referring to, the "menu of possible advertisements" introduced in claim 1 or the "menu of advertisement types" introduced in claim 3. To advance prosecution of the application, the examiner has taken "the menu" to refer to the "menu of advertisement types".

In claim 12, line 1, it is unclear which menu the claim is referring to, the "menu of possible advertisements" introduced in claim 1 or the "menu of advertisement types" introduced in claim 3. To advance prosecution of the application, the examiner has taken "the menu" to refer to the "menu of advertisement types".

In claim 13, line 1, it is unclear which menu the claim is referring to, the "menu of possible advertisements" introduced in claim 1 or the "menu of advertisement types" introduced in claim 3. To advance prosecution of the application, the examiner has taken "the menu" to refer to the "menu of possible advertisements".

In claim 18, line 7, "the stored entertainment content" should be changed to --stored entertainment content--.

In claim 27, line 1, it is unclear which menu the claim is referring to, the "menu of possible advertisements" introduced in claim 1 or the "menu of advertisement types" introduced in claim 3. To advance prosecution of the application, the examiner has taken "the menu" to refer to the "menu of advertisement types".

In claim 28, line 1, it is unclear which menu the claim is referring to, the "menu of possible advertisements" introduced in claim 1 or the "menu of advertisement types" introduced in claim 3. To advance prosecution of the application, the examiner has taken "the menu" to refer to the "menu of advertisement types".

In claim 29, line 1, it is unclear which menu the claim is referring to, the "menu of possible advertisements" introduced in claim 1 or the "menu of advertisement types" introduced in claim 3. To advance prosecution of the application, the examiner has taken "the menu" to refer to the "menu of possible advertisements".

In claim 30, line 1, the dependency upon claim 18 is incorrect. Based upon the claim language, it appears that "claim 18" should be changed to –claim 19--.

In claim 50, line 1, the dependency upon claim 34 is incorrect. Based upon the claim language, it appears that "claim 34" should be changed to –claim 39--.

In claim 52, line 7, "the stored entertainment content" should be changed to --stored entertainment content--.

In claim 66, line 9, "the stored entertainment content" should be changed to --stored entertainment content--.

In claims 87 and 88, line 1, the dependency upon claim 88 is incorrect. Based upon the claim language, it appears that "claim 88" should be changed to –claim 86--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 5, 6, 9, 10, 15, 16, 18, 21, 22, 25, 26, 31-35, 37, 38, 42, 45, 46, 48, and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Barton (US201/0049820).

As to claim 1, Barton discloses a method of advertising (paragraph 26), comprising:

presenting a menu of possible advertisements to a user (paragraph 39 and paragraph 40) to permit the user to select an advertisement to view (paragraph 39 and paragraph 40);

receiving a user selection (Fig. 2; user choosing a particular commercial; paragraph 39, lines 8-11) of an advertisement to view (paragraph 39, lines 8-11); and

merging the advertisement with stored entertainment content (inserting the advertisement into the paused program stream; paragraph 39) so that both the advertisement (paragraphs 39 and 40) and the stored entertainment content (stored

program the user selected; paragraph 29) are presented to the user (wherein the ads are presented during a commercial break in the users selected program; paragraph 30, 39 and 40).

As to claim 2, Barton discloses receiving the selected advertisement from an advertising server (central server; paragraph 49).

As to claim 5, Barton discloses wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement at a location of an advertisement place holder forming a part of the entertainment content (inserting the ads at set commercial breaks in the program; paragraph 39, lines 5-9).

As to claim 6, Barton discloses wherein the selected advertisement is received via a modem (paragraph 49).

As to claim 9, Barton discloses wherein the menu is presented without simultaneous entertainment content (wherein the menu is displayed during ad avail time with no program content; paragraph 40, lines 1-7).

As to claim 10, Barton discloses wherein the menu is presented within a window appearing simultaneously with entertainment content (wherein the menu overlayed onto the broadcast image; paragraph 39).

As to claim 15, Barton discloses caching the selected advertisement in a storage device (storage device, 903; paragraph 49) within a set-top box (within a DVR; paragraphs 49, 27 and 28).

As to claim 16, Barton discloses caching the selected advertisement in a storage device (storage device, 903; paragraph 49) coupled to a set-top box (coupled within a DVR; paragraphs 49, 27 and 28).

As to claim 18, Barton discloses an electronic storage medium (DVR, paragraph 27) containing instructions which, when executed on a programmed processor carry out a process of advertising (paragraph 26), comprising:

presenting a menu of possible advertisements to a user (paragraph 39 and paragraph 40) to permit the user to select an advertisement to view (paragraph 39 and paragraph 40);

receiving a user selection (Fig. 2; user choosing a particular commercial; paragraph 39, lines 8-11) of an advertisement to view (paragraph 39, lines 8-11);

receiving the selected advertisement from an advertising server (central server; paragraph 49); and

merging the advertisement with stored entertainment content (inserting the advertisement into the paused program stream; paragraph 39) so that both the advertisement (paragraphs 39 and 40) and the stored entertainment content (stored

program the user selected; paragraph 29) are presented to the user (wherein the ads are presented during a commercial break in the users selected program; paragraph 30, 39 and 40).

As to claim 21, Barton discloses wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement at a location of an advertisement place holder forming a part of the entertainment content (inserting the ads at set commercial breaks in the program; paragraph 39, lines 5-9).

As to claim 22, Barton discloses wherein the selected advertisement is received via a modem (paragraph 49).

As to claim 25, Barton discloses wherein the menu is presented without simultaneous entertainment content (wherein the menu is displayed during ad avail time with no program content; paragraph 40, lines 1-7).

As to claim 26, Barton discloses wherein the menu is presented within a window appearing simultaneously with entertainment content (wherein the menu overlayed onto the broadcast image; paragraph 39).

As to claim 31, Barton discloses caching the selected advertisement in a storage device (storage device, 903; paragraph 49) within a set-top box (within a DVR; paragraphs 49, 27 and 28).

As to claim 32, Barton discloses caching the selected advertisement in a storage device (storage device, 903; paragraph 49) coupled to a set-top box (coupled within a DVR; paragraphs 49, 27 and 28).

As to claim 33, Barton discloses a set top box (DVR), comprising:

a programmed processor (inherent to the DVR device of Fig. 1) that presents a user with a menu of advertisements (paragraph 39 and paragraph 40);

means for receiving a user selection (Fig. 2; user remote control, 301) of a selected advertisement from the menu of advertisements (paragraph 39, lines 8-11);

advertisement receiving means (a modem) for receiving the selected advertisement from a service provider (paragraph 49);

content receiving means (input section, 101) for receiving entertainment content from the service provider (paragraph 27); and

the programmed processor merging the entertainment content with the advertisement (inserting the advertisement into the paused program stream; paragraph 39) for presentation to the user (wherein the ads are presented during a commercial break in the users selected program; paragraph 30, 39 and 40).

As to claim 34, Barton discloses a storage device (storage device, 903; paragraph 49) forming a part of the set top box (within the DVR; paragraphs 49, 27 and 28) to store the selected advertisement (paragraph 49).

As to claim 35, Barton discloses a storage device (storage device, 903; paragraph 49) coupled to the set top box (coupled within the DVR; paragraphs 49, 27 and 28) to store the selected advertisement (paragraph 49).

As to claim 37, Barton discloses wherein the advertisement receiving means comprises a modem (paragraph 49).

As to claim 38, Barton discloses wherein the means for receiving a user selection comprises an interface to a remote control device (wherein user selections to the DVR are made with a remote control; Fig. 2; paragraph 28, lines 4-6 and paragraph 30, lines 1-5).

As to claim 42, Barton further discloses a modem (paragraph 49) and wherein the selected advertisement is received via the modem (paragraph 49).

As to claim 45, Barton discloses wherein the programmed processor presents the menu without simultaneous entertainment content (wherein the menu is displayed during ad avail time with no program content; paragraph 40, lines 1-7).

As to claim 46, Barton discloses wherein the programmed processor presents the menu within a window appearing simultaneously with entertainment content (wherein the ad menu is overlayed onto the broadcast image; paragraph 39).

As to claim 48, Barton discloses wherein the menu is presented without simultaneous entertainment content (wherein the menu is displayed during ad avail time with no program content; paragraph 40, lines 1-7).

As to claim 49, Barton discloses wherein the menu is presented within a window appearing simultaneously with entertainment content (wherein the menu overlayed onto the broadcast image; paragraph 39).

4. Claims 80-83 and 85-87 are rejected under 35 U.S.C. 102(e) as being anticipated by Ngo et al. (Ngo) (6,574,793).

As to claim 80, Ngo discloses a set-top box (38), comprising:

a programmed processor (processor controlling the device; column 2, lines 16-23 and column 4, lines 23-29) that presents a user with a menu of advertisement types (presenting a menu of variants of a single commercial, such as car type or color; column 5, lines 25-39 and column 6, lines 44-54);

means for receiving (remote, 42) a user selection (column 4, lines 4-15) of a selected advertisement type (user selecting which type they prefer; column 5, lines 36-39) from the menu of advertisements (column 6, lines 44-50);

advertisement receiving means (Fig. 5; tuner, 48) for receiving the selected advertisement (advertisements contained within the transport stream; column 4, lines 30-54) from a service provider (from the cable headend; Fig. 4 and Fig. 10, steps 90-92);

content receiving means (Fig. 5; tuner, 48) for receiving entertainment content from the service provider (television program; column 4, lines 49-54); and

the programmed processor merging the entertainment content with the advertisement (providing the commercial during a break in the programming; column 6, lines 44-54 and column 3, lines 25-34) for presentation to the user (wherein the ad is presented during breaks in the programming; column 6, lines 44-54 and column 3, lines 25-34).

As to claim 81, Ngo discloses a storage device (a disk) forming a part of the set top box (within the set top; column 6, lines 50-54) to store the selected advertisement (advertisements stored on disk; see Ngo at column 6, lines 50-52).

As to claim 82, Ngo discloses a storage device (a disk) coupled to the set top box (coupled to the set top; column 6, lines 50-54) to store the selected advertisement (advertisements stored on disk; see Ngo at column 6, lines 50-52).

As to claim 83, Ngo discloses wherein the advertisement receiving means comprises a tuner (analog tuner, 48; Fig. 5).

As to claim 85, Ngo discloses wherein the means for receiving a user selection comprises an interface to a remote control device (remote control, 42; column 4, lines 4-15).

As to claim 86, Ngo discloses an advertising method, comprising;

presenting a television viewer with a menu of advertisements (different car ads; Fig. 9; column 6, lines 44-54 and column 5, lines 29-36) from which to select an advertisement for viewing (column 6, lines 44-54);

receiving an advertisement selection from the television viewer (column 6, lines 47-54); and

presenting the television viewer with the selected advertisement (column 6, lines 44-50 and column 4, lines 25-42).

As to claim 87, Ngo further discloses:

presenting the television viewer with a menu (column 6, lines 44-54) of advertisement types (column 5, lines 15-17 and lines 29-39);

receiving an advertisement type selection from the television viewer (column 6, lines 47-54 and column 5, lines 36-39); and

presenting the television viewer with the selected advertisement (the particular car ad; column 5, lines 29-36) according to the selected advertisement type (according to a particular color desired by the viewer; column 5, lines 36-39).

5. Claims 86 and 87 are rejected under 35 U.S.C. 102(e) as being anticipated by Hooks et al. (Hooks) (6,169,542).

As to claim 86, Hooks discloses an advertising method, comprising;

presenting a television viewer with a menu of advertisements (Fig. 8; column 10, lines 64-66 and column 11, lines 8-19) from which to select an advertisement for viewing (column 11, lines 11-18);

receiving an advertisement selection from the television viewer (column 11, lines 19-30 and lines 38-42); and

presenting the television viewer with the selected advertisement (presenting the viewer with supplemental menus, information, links or video related to the advertisement; column 11, lines 44-65).

As to claim 87, Hooks further discloses:

presenting the television viewer with a menu of advertisement types (such as a the display of info related to a product and linking to the website advertising the product; Fig. 9; column 11, lines 53-65);

receiving an advertisement type selection from the television viewer (column 11, lines 66-67 and column 12, lines 1-9 and lines 50-58); and

presenting the television viewer with the selected advertisement (information concerning the advertisement the viewer is interested in; column 11, lines 63-65 and lines 66-67 and column 12, lines 1-9 and lines 50-58) according to the selected advertisement type (according to the format desired, such as a more info window versus linking to a website; column 11, lines 66-67 and column 12, lines 1-9 and lines 50-58).

6. Claims 90 and 92 are rejected under 35 U.S.C. 102(e) as being anticipated by Reichardt et al. (Reichardt) (US2002/0124255A1).

As to claim 90, Reichardt discloses an advertising method (paragraph 80), comprising;

presenting the television viewer with a menu (paragraph 79) of advertisement types (different selectable advertisements, 108 performing different functions; paragraph 80);

receiving an advertisement type selection from the television viewer (user selecting a particular one of the ads; paragraph 80, lines 5-8); and

presenting the television viewer with the selected advertisement (paragraph 80, lines 5-8 and paragraph 89) according to the selected advertisement type (according to which ad was selected; paragraphs 80 and 89).

As to claim 92, Reichardt discloses wherein the advertisement type is selected from a first (Fig. 5; upper box 108) and a second advertisement type (Fig. 5; lower box 108), with the first advertisement type being considered more intrusive to the viewer

than the second advertisement type (wherein a type which involve forcibly tuning the user to a separate channel is more intrusive then simply displaying additional information; paragraphs 80 and 89).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 8, 24, 44 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton.

As to claims 8, 24, 44 and 47, while Barton discloses a menu (paragraph 39 and paragraph 40), he fails to specifically disclose a scrolling banner appearing simultaneously with entertainment content.

The examiner takes official notice that it is notoriously well known to utilize a scrolling banner which appears simultaneously with entertainment content, wherein the banner will scroll to provide more information then could be displayed at once in the banner, for the typical benefit of providing a more efficient use of the display area by utilizing a smaller portion of the display to provide additional information to a user.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Barton's system to include a scrolling banner appearing simultaneously with entertainment content for the typical benefit of more efficiently

utilizing a display by providing a means utilize a smaller portion of the display area to provide additional information to a user.

9. Claim 88 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ngo.

As to claim 88, while Ngo discloses presenting an advertisement when the advertisement is selected by viewers, he fails to specifically disclose charging an advertiser based upon the number of times the advertisement is selected by a group of television viewers.

The examiner takes official notice that it is notoriously well known in the art to charge an advertiser based upon the number of times the advertisement is presented to viewers, which is determined by the number of times the advertisement is selected by the group of television viewers, for the typical benefit of ensuring that advertisers are charged for each presentation of their advertisement to viewers.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Ngo's system to include charging an advertiser based upon the number of times the advertisement is selected by a group of television viewers for the typical benefit of ensuring that advertisers are charged for each instance their advertisement is provided to viewers.

10. Claims 3, 4, 7, 11-14, 19, 20, 23, 27-30, 36, 39-41, 43 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton as applied to claims 1, 18 and 33 above, and further in view of Ngo.

As to claims 3, 19 and 39, while Barton discloses presenting a menu of advertisements to a user for selection, he fails to specifically disclose a menu of advertisement types.

In an analogous art, Ngo discloses a television system (Fig. 3) wherein a set top box (38) will present a menu to a user (column 6, lines 44-54) for a user to select a particular type of advertisement (selecting a particular variant of a single commercial, such as car type or color; column 5, lines 25-39) for the typical benefit of allowing a user to select the particular type of an advertisement which most suits them (column 5, lines 25-39 and column 3, lines 40-42).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Barton's system to include a menu of advertisement types, as taught by Ngo, for the typical benefit of allowing a user to further customize their advertisement viewing through the selection of the type advertisement which most suits them.

As to claims 4, 20 and 40, Barton and Ngo disclose wherein the advertisement types include a conventional commercial segment (advertisement provided during a break in television programming; see Ngo at Figs. 1 and 2; column 3, lines 25-34).

As to claim 41, Barton and Ngo disclose wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement at a location of an advertisement place holder forming a part of the entertainment content (wherein the

ads are inserted at set breaks within the programming; see Ngo at column 3, lines 25-34).

As to claims 7, 23, 36 and 43, while Barton discloses wherein the selected advertisement via a modem (paragraph 49), he fails to specifically disclose receiving the advertisement through a television channel.

In an analogous art, Ngo discloses a system (Fig. 3) for inserting user selected advertisements into programming (column 3, lines 25-42) wherein the advertisements are received through a tuner (analog tuner, 48) via a television channel (advertisements contained within a stream with the television programs; Fig. 2, Fig. 5 and column 4, lines 30-58) for the typical benefit of eliminating the need for a separate transmission path by providing the advertisements in a television channel with the television programming (column 4, lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Barton's system to include receiving the advertisement through a television channel, as taught by Ngo, for the typical benefit of enabling the viewer to receive advertisements with the television programming instead of through a separate transmission path.

As to claims 11 and 27, while Barton and Ngo disclose a menu (see Ngo at Fig. 9), they fail to specifically disclose a scrolling banner appearing simultaneously with entertainment content.

The examiner takes official notice that it is notoriously well known to utilize a scrolling banner which appears simultaneously with entertainment content, wherein the banner will scroll to provide more information then could be displayed at once in the banner, for the typical benefit of providing a more efficient use of the display area by utilizing a smaller portion of the display to provide additional information to a user.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Barton and Ngo's system to include a scrolling banner appearing simultaneously with entertainment content for the typical benefit of more efficiently utilizing a display by providing a means utilize a smaller portion of the display area to provide additional information to a user.

As to claims 12 and 28, Barton and Ngo disclose wherein the menu (the advertisement type menu) is presented without simultaneous entertainment content (see Ngo at Fig. 9).

As to claims 13 and 29, Barton and Ngo disclose wherein the menu (the advertisement menu) is presented within a window simultaneously with entertainment content (wherein the menu overlayed onto the broadcast image; see Barton at paragraph 39).

As to claims 14, 30 and 50, Barton and Ngo disclose wherein the advertisement and the advertisement type is presented to the user in a single menu (wherein an

advertisement and variants created by the set top are presented to the user; see Ngo at column 6, lines 44-54 and column 5, lines 25-39).

11. Claims 52-59, 61-73, 75-79 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ngo in view of Barton.

As to claim 52, while Ngo discloses a method of advertising (column 3, lines 25-42), comprising:

presenting a menu (Fig. 9) of possible types of advertisements to a user (selecting a particular variant of a single commercial, such as car type or color; column 5, lines 25-39 and column 6, lines 44-54) to permit the user to select a type of advertisement to view (use selecting which type they prefer; column 5, lines 36-39);

receiving a user selection of a type of advertisement to view (column 6, lines 44-50);

receiving an advertisement of the selected advertisement type (wherein all ads are received through the broadcast signal; column 4, lines 60-67 and column 5, lines 1-24) from an advertising server (the cable headend; Fig. 10, steps 90-92; column 7, lines 19-23); and

merging the advertisement with entertainment content (providing the commercial during a break in the programming; column 6, lines 44-54 and column 3, lines 25-34) so that both the advertisement and the entertainment content are presented to the user (wherein the ad is presented during breaks in the programming; column 6, lines 44-54 and column 3, lines 25-34), he fails to specifically disclose stored entertainment content.

In an analogous art, Barton discloses a system (Fig. 1) wherein a user selects advertisements from a menu (paragraph 39) which are to be inserted into stored entertainment content (paragraphs 27 and 28) for the typical benefit of allowing a user to store program content to be displayed at a later time (paragraph 30).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Ngo's system to include stored entertainment content, as taught by Barton, for the typical benefit of allowing a user to store program content to be displayed at a later time.

As to claim 53, Ngo and Barton disclose presenting a menu of advertisements to the user for selection (wherein the variants are all different ads to select; see Ngo at column 6, lines 44-54 and column 5, lines 25-39).

As to claim 54, Ngo and Barton disclose wherein the advertisement types include a conventional commercial segment (advertisement provided during a break in television programming; see Ngo at Figs. 1 and 2; column 3, lines 25-34)

As to claim 55, Ngo and Barton disclose wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement at a location of an advertisement place holder forming a part of the entertainment content (wherein the ads are inserted at set breaks within the programming; see Ngo at column 3, lines 25-34).

As to claim 56, Ngo and Barton disclose wherein the selected advertisement is received via a modem (see Barton at paragraph 49).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to further modify Ngo and Barton's system to include wherein the selected advertisement is received via a modem, as further taught by Barton, for the typical benefit of conserving bandwidth in the television transmission channels by receiving the advertisements through a modem.

As to claim 57, Ngo and Barton disclose wherein the selected advertisement is received via a television channel (see Ngo at Fig. 2; column 4, lines 34-41 and 60-67).

As to claim 58, while Ngo and Barton disclose a menu (see Ngo at Fig. 9), they fail to specifically disclose a scrolling banner appearing simultaneously with entertainment content.

The examiner takes official notice that it is notoriously well known to utilize a scrolling banner which appears simultaneously with entertainment content, wherein the banner will scroll to provide more information then could be displayed at once in the banner, for the typical benefit of providing a more efficient use of the display area by utilizing a smaller portion of the display to provide additional information to a user.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Barton and Ngo's system to include a scrolling banner

appearing simultaneously with entertainment content for the typical benefit of more efficiently utilizing a display by providing a means utilize a smaller portion of the display area to provide additional information to a user.

As to claim 59, Ngo and Barton disclose wherein the menu (the type menu) is presented without simultaneous entertainment content (see Ngo at Fig. 9).

As to claim 61, Ngo and Barton disclose caching the selected advertisement in a storage device (disk) within a set-top box (advertisements stored on disk; see Ngo at column 6, lines 50-52).

As to claim 62, Ngo and Barton disclose caching the selected advertisement in a storage device (disk) coupled to a set-top box (inherently coupled to the set top; see Ngo at column 6, lines 50-52).

As to claim 63, Ngo and Barton disclose wherein the advertisement is merged with the stored entertainment content (wherein the ad is merged for transmission with the program; see Ngo at Fig. 2; column 4, lines 30-41 and 49-54) at a service provider (at a cable headend; see Ngo at Fig. 10; steps 90-92).

As to claim 64, Ngo and Barton disclose wherein the advertisement is merged with the stored entertainment content (wherein the ad is merged for transmission with

the program; see Ngo at Fig. 2; column 4, lines 30-41 and 49-54) at a service provider headend (at a cable headend; see Ngo at Fig. 10; steps 90-92).

As to claim 65, Ngo and Barton disclose wherein the advertisement is merged with the stored entertainment content at a set-top box (wherein the set top can merge and create the ads for display during the program; see Ngo at column 3, lines 25-34, lines 63-65 and column 5, lines 25-39).

As to claim 66, while Ngo discloses an electronic storage medium (set top box, 38) containing instructions (inherent to a computer processor; column 2, lines 16-23) which, when carried out by a programmed processor (controller containing a processor; column 2, lines 16-23), implements a method of advertising (column 3, lines 25-42), comprising:

presenting a menu (Fig. 9) of possible types of advertisements to a user (selecting a particular variant of a single commercial, such as car type or color; column 5, lines 25-39 and column 6, lines 44-54) to permit the user to select a type of advertisement to view (use selecting which type they prefer; column 5, lines 36-39);

receiving a user selection of a type of advertisement to view (column 6, lines 44-50);

receiving an advertisement of the selected advertisement type (wherein all ads are received through the broadcast signal; column 4, lines 60-67 and column 5, lines 1-

24) from an advertising server (the cable headend; Fig. 10, steps 90-92; column 7, lines 19-23); and

merging the advertisement with entertainment content (providing the commercial during a break in the programming; column 6, lines 44-54 and column 3, lines 25-34) so that both the advertisement and the entertainment content are presented to the user (wherein the ad is presented during breaks in the programming; column 6, lines 44-54 and column 3, lines 25-34), he fails to specifically disclose stored entertainment content.

In an analogous art, Barton discloses a system (Fig. 1) wherein a user selects advertisements from a menu (paragraph 39) which are to be inserted into stored entertainment content (paragraphs 27 and 28) for the typical benefit of allowing a user to store program content to be displayed at a later time (paragraph 30).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Ngo's system to include stored entertainment content, as taught by Barton, for the typical benefit of allowing a user to store program content to be displayed at a later time.

As to claim 67, Ngo and Barton disclose presenting a menu of advertisements to the user for selection (wherein the variants are all different ads to select; see Ngo at column 6, lines 44-54 and column 5, lines 25-39).

As to claim 68, Ngo and Barton disclose wherein the advertisement types include a conventional commercial segment (advertisement provided during a break in television programming; see Ngo at Figs. 1 and 2; column 3, lines 25-34)

As to claim 69, Ngo and Barton disclose wherein merging the advertisement with the stored entertainment content comprises inserting the advertisement at a location of an advertisement place holder forming a part of the entertainment content (wherein the ads are inserted at set breaks within the programming; see Ngo at column 3, lines 25-34).

As to claim 70, Ngo and Barton disclose wherein the selected advertisement is received via a modem (see Barton at paragraph 49).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to further modify Ngo and Barton's system to include wherein the selected advertisement is received via a modem, as further taught by Barton, for the typical benefit of conserving bandwidth in the television transmission channels by receiving the advertisements through a modem.

As to claim 71, Ngo and Barton disclose wherein the selected advertisement is received via a television channel (see Ngo at Fig. 2; column 4, lines 34-41 and 60-67).

As to claim 72, while Ngo and Barton disclose a menu (see Ngo at Fig. 9), they fail to specifically disclose a scrolling banner appearing simultaneously with entertainment content.

The examiner takes official notice that it is notoriously well known to utilize a scrolling banner which appears simultaneously with entertainment content, wherein the banner will scroll to provide more information then could be displayed at once in the banner, for the typical benefit of providing a more efficient use of the display area by utilizing a smaller portion of the display to provide additional information to a user.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Barton and Ngo's system to include a scrolling banner appearing simultaneously with entertainment content for the typical benefit of more efficiently utilizing a display by providing a means utilize a smaller portion of the display area to provide additional information to a user.

As to claim 73, Ngo and Barton disclose wherein the menu is presented without simultaneous entertainment content (see Ngo at Fig. 9).

As to claim 75, Ngo and Barton disclose caching the selected advertisement in a storage device (disk) within a set-top box (advertisements stored on disk; see Ngo at column 6, lines 50-52).

As to claim 76, Ngo and Barton disclose caching the selected advertisement in a storage device (disk) coupled to a set-top box (inherently coupled to the set top; see Ngo at column 6, lines 50-52).

As to claim 77, Ngo and Barton disclose wherein the advertisement is merged with the stored entertainment content (wherein the ad is merged for transmission with the program; see Ngo at Fig. 2; column 4, lines 30-41 and 49-54) at a service provider (at a cable headend; see Ngo at Fig. 10; steps 90-92).

As to claim 78, Ngo and Barton disclose wherein the advertisement is merged with the stored entertainment content (wherein the ad is merged for transmission with the program; see Ngo at Fig. 2; column 4, lines 30-41 and 49-54) at a service provider headend (at a cable headend; see Ngo at Fig. 10; steps 90-92).

As to claim 79, Ngo and Barton disclose wherein the advertisement is merged with the stored entertainment content at a set-top box (wherein the set top can merge and create the ads for display during the program; see Ngo at column 3, lines 25-34, lines 63-65 and column 5, lines 25-39).

As to claim 84, while Ngo discloses wherein the selected advertisement is received via a tuner, he fails to specifically disclose wherein the advertisement is received via a modem.

In an analogous art, Barton discloses a system (Fig. 1) wherein a user selects advertisements from a menu (paragraph 39) which are received via a modem (paragraph 49) for the typical benefit of conserving bandwidth in the television transmission channels by receiving the advertisements through a modem.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Ngo's system to include wherein the selected advertisement is received via a modem, as taught by Barton, for the typical benefit of conserving bandwidth in the television transmission channels by receiving the advertisements through a modem.

12. Claims 60 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ngo and Barton as applied to claims 52 and 66 above, and further in view of Reichardt et al. (Reichardt) (US2002/0124255).

As to claims 60 and 74, while Ngo and Barton disclose wherein the menu is presented within a window, they fail to specifically disclose wherein the menu is presented simultaneously with entertainment content.

In an analogous art, Reichardt discloses a system (Fig. 3) which will display a menu of multiple advertisements for a user to select (Fig. 5; paragraphs 79 and 80) simultaneously with entertainment content (in video window, 501; Fig. 5; paragraph 81) for the typical benefit of enabling the viewer to continue viewing entertainment content while navigating a menu.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Ngo and Barton's system to include wherein the menu is presented simultaneously with entertainment content, as taught by Reichardt, for the typical benefit of ensuring the user can continue viewing the entertainment content uninterrupted while navigating a menu.

13. Claims 17 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton as applied to claims 1 and 33 above, and further in view of Reichardt.

As to claims 17 and 51, while Barton discloses presenting the menu, he fails to disclose wherein presenting the menu takes place as a result of receipt of a signal from the user requesting the presentation of the menu.

In an analogous art, Reichardt discloses a system (Fig. 3) which will display a menu of multiple advertisements for a user to select (Fig. 5; paragraphs 79 and 80) upon receipt of a signal from a user requesting the menu (user pressing menu button on remote control; paragraph 79) for the typical benefit of providing the viewer with more control over when the menu is to be displayed.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Ngo and Barton's system to include wherein presenting the menu takes place as a result of receipt of a signal from the user requesting the presentation of the menu, as taught by Reichardt, for the typical benefit of providing the viewer with more control over when the menu is to be displayed.

14. Claim 89 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hooks.

As to claim 89, while Hooks discloses presenting the advertisement to viewers when it is selected based upon the selected advertisement type, he fails to specifically disclose charging an advertiser based upon a number of times the advertisement is selected by a group of television viewers and based upon the selected advertisement type presented.

The examiner takes official notice that it is notoriously well known in the art to charge an advertiser based upon the number of times the advertisement is selected by viewers and based upon the selected advertisement type presented, such as for example, if a viewer selects a link to access an advertised website, it is well known for the advertiser to pay a set fee for each viewer who selected the link and was then routed to their website, for the typical benefit of encouraging the service provider to inform viewers of the website and allowing viewers to access it.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Hooks' system to include charging an advertiser based upon a number of times the advertisement is selected by a group of television viewers and based upon the selected advertisement type presented for the typical benefit of encouraging the service provider to inform viewers of the website and allowing viewers to access it.

15. Claims 91 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reichardt.

As to claim 91, Reichardt discloses presenting the selected advertisement based upon the selected advertisement type, he fails to specifically disclose charging an advertiser for presenting the advertisement based upon the selected advertisement type presented.

The examiner takes official notice that it is notoriously well known in the art to charge an advertiser each time their advertisement is presented to viewers, wherein the current advertisement is presented upon viewer selection of that particular advertisement type, for the typical benefit of ensuring that advertisers are charged for each presentation of their advertisement to viewers.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Reichardt's system to include charging an advertiser for presenting the advertisement based upon the selected advertisement type presented for the typical benefit of ensuring that advertisers are charged for each instance their advertisement is provided to viewers.

As to claim 93, while Reichardt discloses wherein the presenting comprises presenting the first advertisement type for a first period of time if selected (wherein the selected ad is then presented to the user for some period of time; paragraphs 80 and 89), and presenting the second advertisement type for a second period of time if selected (wherein the selected ad is then presented to the user for some period of time; paragraphs 80 and 89), he fails to specifically disclose the first period of time being less than the second period of time.

The examiner takes official notice that it is notoriously well known in the art for advertisements to be of different durations, with some advertisements displayed for lesser periods of time then others, wherein a shorter duration advertisement generally costs less for the advertiser to present, for the typical benefit of allowing advertisers more control over the durations and costs associated with their advertisements.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Reichardt's system to include the first period of time being less than the second period of time for the typical benefit of allowing advertisers more control over the durations and costs associated with their advertisements.

Conclusion

16. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____.
(Date)

Typed or printed name of person signing this certificate:

_____

Signature: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)_____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

_____

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (703) 305-8722. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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